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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,320	12/29/2000	Raul S. San Martin	10360-077001 / 12299RO	9159

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EXAMINER	
FAROOQ, MOHAMMAD O	

ART UNIT	PAPER NUMBER
2182	8

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/751,320	Applicant(s) SAN MARTIN ET AL.	
	Examiner Mohammad O. Farooq	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 January 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 December 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Claim 22 is objected to because of the following informalities: this claim states being dependent upon method claim 15, but claim 15 is a computer program product claim. This office action treats claim 22 being dependent upon computer program product claim 15. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichols et al. U.S. Pat. No. 6,363,282 B1 in view of Jones U.S. Pat. No. 6,526,574 B1.

3. As to claim 1, Nichols et al. teach method implemented in a computer application for updating software on a programmable device, the method comprising:

providing two way communication between a server (data center) and the programmable device (programmer; col. 8, line 61 – col. 9, line 4; fig. 6);

configuring an updating process that executes on the server (i.e. information network; item 142, 144; fig. 6);

updating the programmable device that executes on the server (items 146-156; fig. 6);

Nichols et al. do not teach testing the operation of at least a portion of the updated software on the programmable device. Jones teaches testing the operation of at least a portion of the updated software on the programmable device (i.e. automatic verification that correct files have been used; abstract). However, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Nichols et al. and Jones because that would provide error checking for the system (col. 1, lines 56-60).

4. As to claims 2-4, Nichols et al. do not teach backing up at lest a portion of the pre-existing software on the programmable device; based upon the testing, restoring the backed portion of the software on the programmable device; backing up occurring on the programmable device and at the server. Jones teaches backing up at lest a portion of the pre-existing software on the programmable device; based upon the testing, restoring the backed portion of the software on the programmable device; backing up occurring on the programmable device and at the server (abstract; col. 1, lines 56 – 60; col. 2, lines 24-34).

However, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Nichols et al. and Jones because that would provide multiple changes in an existing file (or software) of the system (col. 1, lines 62-64).

5. As to claim 5, Nichols et al. teach wherein the communications is over the Internet (WAN; col. 6, lines 38-60).

6. As to claim 6-8, Nichols et al. teach the server signaling the programmable device to shut down and restart prior to the backing up action; user definable delay between the signaling and the shutting down; and sending a signal to a uses based upon an outcome of the testing (i.e. real-time parametric and operational changes; col. 5, line 66 – col. 6, line 60).

7. As to claim 9, Nichols et al. teach system for updating software on a programmable device comprising:

a server (data center; col. 8, line 61 – col. 9, line 4; fig. 6);

a programmable device (programmer) able to be in two way communication with the server (col. 8, line 61 – col. 9, line 4; fig. 6);

the server comprising computer software instructions to cause the server to

configure an update process (i.e. information network; item 142, 144; fig. 6);

update software on the programmable device in accordance with the update process (items 146-156; fig. 6);

Nichols et al. do not teach testing the operation of at least a portion of the updated software on the programmable device. Jones teaches testing the operation of at least a portion of the updated software on the programmable device (i.e. automatic verification that correct files have been used; abstract). However, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Nichols et al. and Jones because that would provide error checking for the system (col. 1, lines 56-60).

8. As to claim 15, Nichols et al. teach computer program product, tangibly stored on a computer –readable medium, for updating software on a programmable device, comprising instructions operable to cause a programmable processor (inherent in a device) to:

configure an update process (item 142, 144; fig. 6);

communicate with the programmable device over a two way communications medium ((col. 8, line 61 – col. 9, line 4; fig. 6); and

update software on the programmable device in accordance with the update process (items 146-156; fig. 6).

Nichols et al. do not teach backup at least a portion of the software on the programmable device and testing the operation of at least a portion of the updated software on the programmable device. Jones teaches backup at least a portion of the software on the programmable device (abstract) and testing the operation of at least a portion of the updated software on the programmable device (i.e. automatic verification that correct files have been used; abstract). However, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Nichols et al. and Jones because that would provide error checking for the system (col. 1, lines 56-60).

9. Claims 10-14 are apparatus claims of method claims 2 and 4-7. Nichols et al. and Jones in combination teach method as set forth in claims 2 and 4-7. Therefore, Nichols et al. and Jones in combination also teach apparatus as set forth in claims 10-14.

10. Claims 16-22 are computer program product claims of method claims 2-8. Nichols et al. and Jones in combination teach method as set forth in claims 2-8. Therefore, Nichols et al. and Jones in combination also teach computer program product as set forth in claims 16-22.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad O. Farooq whose telephone number is (703) 305-3888. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Mohammad O. Farooq
May 2, 2004